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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,399	11/14/2003	Kevin M. Moore	1533.3500003	6849
7590		05/23/2007		
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			EXAMINER	
			OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	
			MAIL DATE	DELIVERY MODE
			05/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/712,399	MOORE ET AL.	
	Examiner	Art Unit	
	Taylor Victor Oh	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,13-61,63,65 and 66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-10,13-61,63,65 and 66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Applicant's arguments with respect to claims 1-2, 5-10, 13-61,63, and 65-66 have been considered but are moot in view of the new ground(s) of rejection.

**The Status of Claims**

Claims 1-2, 5-10, 13-61,63, and 65-66 are pending.

Claims 1-2, 5-10, 13-61,63, and 65-66 are rejected.

**DETAILED ACTION**

**Priority**

1. It is noted that this application is a CIP of 09/955,672 filed on 09/19/2001(US 6,849,748), which claims benefit of 60/244,962 (11/01/2000).

**Drawings**

2. The drawing filed on 11/14/03 is accepted by the examiner .

***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5-10, 13-61,63, and 65-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brinegar et al (WO 00/14081) in view of Feldmann et al (U.S. 4,564,692).

Brinegar et al teaches the followings (see from page 5 ,line 24 to page 6 , line 27)

:

**The process is directed toward the production of anhydrosugar alcohols and generally includes the steps of introducing at least one sugar alcohol or monoanhydrosugar alcohol into a reaction vessel; dehydrating the sugar alcohol or monoanhydrosugar alcohol in the presence of an acid catalyst and a solvent to**

form a reaction product which is at least partly soluble in the solvent; removing water from the reaction vessel; removing solvent comprising the dissolved reaction product from the reaction vessel; separating the reaction product from the removed solvent; and recycling the solvent into the reaction vessel. Optionally, the process may further include an additional purification step. Further, the process may be continuous such that the steps of introducing in the starting materials, removing water, removing solvent comprising the dissolved reaction product and recycling the solvent after separation from the reaction product occur simultaneously.

The dehydration is desirably performed at elevated temperatures between 80°C and 180°C, preferably at temperatures between 120°C and 140°C, and most preferably between 130°C and 140°C. It is advantageous to perform the dehydration under a protective or non-reactive gas atmosphere, particularly nitrogen. The dehydration can be performed at atmospheric pressure, although elevated or reduced pressures can also be used with minor adjustments to process parameters such as time and temperature, as known to one of ordinary skill in the art.

During the dehydration, the reaction mixture is preferably kept under reflux conditions in order to remove water by azeotropic distillation. Water may also be removed by other methods known in the art, such as evaporation.

(see page 8 , lines 7-14).

Further purification of the crude reaction product may occur by distillation, recrystallization, melt recrystallization or a combination thereof, as described in detail in copending application [Atty Docket No. 032358-018], filed on even date (see col. 11 ,lines 8-10).

Typical sugar alcohols, in particular pentites and hexites, are suitable for use in the process as starting materials. The starting materials may be sugar alcohols, monoanhydrosugar alcohols, or a mixture thereof. In particular, preferred starting materials include arabinitol, ribitol, D-glucitol (also known as D-sorbitol or sorbitol), D-mannitol (mannitol), galactitol and iditol. The use of sorbitol is particularly desirable because sorbitol is readily available and can be obtained on a large industrial scale by the reduction of glucose with hydrogen, as known to one of ordinary skill in the art.

The catalysts used to facilitate the dehydration reaction are acid catalysts. Several types of acid catalysts may be used, each having specific advantages and disadvantages. One class of acid catalyst that may be used includes soluble acids. Examples of such acid catalysts include sulfuric acid, phosphoric acid, p-toluene sulfonic acid, methanesulfonic acid and the like. Sulfuric acid is a preferred catalyst from this class. Alternatively, acid anion exchange resins may also be used, such as sulfonated polystyrenes. A preferred acid anion exchange resin is AG50W-X12 from BioRad. Inorganic ion exchange materials may also be used, such as acidic zeolites. In particular, H-beta zeolite from Degussa may be used in the process disclosed herein.

The instant invention differs from Hartmann in that filtering and centrifuging the anhydrosugar alcohol are unspecified; the acidic ion exchange resin is added in an amount of from 0.01 to 0.15 gram equivalents to sugar alcohol; the claimed process is conducted in the absence of solvents

Feldmann et al teaches a process of purifying the anhydro sugar alcohols by crystallization from an aqueous solution or melts at a high degree of selectivity and purity (see col. 2 ,lines 39-40) in the absence of organic crystallization solvents (see col. 1 ,lines 65-67). Furthermore, all aqueous anhydro sugar alcohol solutions with a suitable concentration have been obtained from acid-catalyzed dehydration of hexitols (see col. 4 ,lines 9-11) with strongly acidic cationic exchange resins (see col. 4 ,lines 60-61); the crystalline anhydro sugar alcohols can be separated from the mixture by centrifugation or filtration (see col. 4 ,lines 25-27). In addition, if the heavy liquors contain two or more different anhydro sugar alcohols, it is possible to use fractional crystallization in succession in order to produce the pure crystalline form (see col. 4 ,lines 35-39); also, it is advisable to conduct the crystallization process at a temperature of from 20 to 65° C. (see col. 3 ,lines 18-19).

Concerning the addition of the amount of from 0.01 to 0.15 gram equivalents of resin to sugar alcohol, the limitation of a process with respect to ranges of pH, ratio and period does not impart patentability to a process when such values are those which would be determined by one of ordinary skill in the art in achieving optimum operation of the process. Ratio is well understood by those of ordinary skill in the art to be result-effective variables, especially when attempting to control selectivity of a chemical process in the absence of an unexpected result.

Brinegar et al does disclose the process of preparing anhydrosugar alcohols, such as sorbitol by dehydration in the presence of the acid catalyst and solvent; similarly, Feldmann et al expressly teaches the process of purifying the anhydro sugar alcohols obtained from acid-catalyzed dehydration of hexitols by crystallization from a concentrated solution in the absence of organic crystallization solvents; moreover, when sugar alcohols are dehydrated, the reaction mixtures contain various impurities detrimental to the production of polyesters (see col. 1 ,lines 23-30). Furthermore, Feldmann et al has offered guidance that the process can be conducted in the presence of solvent or its absence of it. Therefore, it would have been obvious to the skilled artisan in the art to be motivated to incorporate the Feldmann's et al teaching of using the absence of solvent into the Brinegar's et al process as an alternative in order to obtain the desired product a high degree of selectivity and purity (see col. 2 ,lines 39-40). This is because the skilled artisan in the art would expect such a combination to be feasible as shown in the Feldmann et al prior art.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Taylor Victor Oh, MSD, LAC  
Primary Examiner  
Art Unit : 1625

5/18/07